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09/857,042	02/25/2002	Nicholas Luke Bennett	007051.P011	7776
23446 7590 10/27/2009 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661				
EXAMINER				
SHAH, MILAP				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/857,042

**Applicant(s)**

BENNETT ET AL.

**Examiner**

MILAP SHAH

**Art Unit**

3714

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 72-74, 77-80, 84, 87-95, 97, 103 and 106-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 72-74, 77-80, 84, 87-95, 97, 103 and 106-114 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/19/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2008 has been entered.

The Examiner acknowledges applicant's response received July 20, 2009 to the notice of non-responsive amendment mailed February 19, 2009. Currently, claims 72-74, 77-80, 84, 87-95, 97, 103, and 106-114 are pending as filed July 20, 2009.

### ***Information Disclosure Statement***

The information disclosure statement filed November 19, 2008 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 72-74, 77-79, 103, 106, & 107 are rejected under 35 U.S.C. 102(b) as being anticipated by Ugawa (Japanese Publication No. 09-047550, published February 18, 1997). A machine translation to English of the abstract, claims and detailed description was provided in a previous office action.

**Claim 72 & 73:** Ugawa generally discloses the same invention including a gaming machine with a display and a game controller as is known in the art (see at least figures 1-4), where the game controller is arranged to play a game wherein one or more random events are caused to be displayed on the display and, if a predetermined winning event or combination of events results, the machine awards a prize, the console being characterized in that an animated character is periodically displayed to communicate information to the player, the character being arranged to appear superimposed over any game screen currently displayed at the time the character is displayed, the character appearing to at least control the dispensing of a prize (abstract, figures 36-42, and paragraphs 0033-0042). Generally, Ugawa discloses the character appears to provide information as to the dispensing or controlling of a prize, such that the predictive information is associated with a prize winning jackpot or outcome that'll eventually hit in subsequent games. Ugawa discloses the character appears at least to delivery predictive information regarding a big hit or big jackpot, such that the occurrence of the character appears to be independent of the specific outcome of the game being played, but rather the character appears randomly based on a trigger signal through "WC RND RCH" of the flowchart shown in at least figure 26 (paragraph 0033 discloses when the value of the variable "WC RND RCH" is under 10, the superposition of the character on the game screen is started). The triggering of the appearance of the character is clearly associated with a function or feature selected from a plurality of functions or features associated with the game console (i.e. triggering is random, which is one feature of many available on the game console, where another feature is the spinning of the reels; "feature or function" in the context of the claim appears broad). Moreover, the visual appearance of the character is

periodic and random based on the ready-for-winning state (as discussed by the Applicant in the most recent remarks), where such periodic and random appearance of the character is also implicitly related to the amount of a bet placed on the gaming machine, such as a minimum bet that must be placed in the gaming machine to activate said gaming machine to provide the player with the game play and to receive the random appearance of the visual character.

**Claim 74:** Ugawa discloses various “features” such as the predetermined predictive information to be displayed by the character, where the character is able to show various statements as disclosed by paragraphs 0033-0034, such that the trigger signal must include a portion to indicate which of the messages will be displayed after initiation of that particular “feature”. These separate features each have a separate probability of occurring as discussed by Ugawa all throughout the disclosure of the invention.

**Claims 77-79:** Ugawa discloses another trigger symbol associated with the primary game being the pachinko game (figure 1), where the ball lands in a certain area triggering the “bonus” game of the video display; thus, it’s clear the bonus or secondary game starts after the completion of the primary game, simply because when the ball lands in the area to initiate the trigger signal, that primary game has been completed (paragraph 0023). It is understood in the art that bonus games are automatically commenced, thus, the player would not be given the opportunity to bet again until completion of the bonus round. Regarding claim 79, the first function associated with the character appears to be the primary game play with the predictive information being displayed and second function appears to be the secondary or bonus game play, where the primary and secondary game play resulting from the first bet are completed prior to a second bet can be placed, such as a second bet on a second primary game.

**Claim 103:** Ugawa clearly discloses the information is displayed at least in symbols and/or text (figures 36-42).

**Claim 106:** As discussed above in accordance with the “WC RND RCH” parameter, it appears the character is based upon at least a random trigger event.

**Claim 107:** Ugawa discloses the character is triggered at least for the purpose of providing predictive information in accordance with a probability of hitting a bonus award (see entire disclosure referencing “probabilities” throughout).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 80, 84, 87-95, 97, & 108-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa, as applied to claims 72-74, 77-79, 103, 106, & 107, where applicable.

**Claims 80, 84, 87-95, & 97:** Ugawa discloses the invention substantially as claimed except for explicitly disclosing:

the character indicating a reel to be indicated as a wild, where the character indicates such by climbing into the foreground of that reel (claims 87-88);

the character offering a selection between two or more objects, such as the animated character holding two objects, the objects may be money or box representations, or bonus features, the player choosing one of the objects (claims 89-92);

the character awarding free games, a multiplier, and/or other prizes (claims 93 & 94); and

the character causing reels to spin in a primary and game and awards bonus games, wherein the primary game is a slot game versus a pachinko game (obvious variant), and the bonus game as in Ugawa is a slot game having associated awards (claims 80, 84, 95, & 97).

Regardless of these deficiencies, they would have been an obvious matter of design choice to those of ordinary skill at the time of the invention. The Applicant has not stated that such specific aesthetic functions of the character provide any particular unexpected result or solve any stated problem, and it appears the gaming machine would perform equally well with the character simply performing the tasks as disclosed by Ugawa. For example, the primary game being a slot game versus a pachinko game is considered a mere design consideration, as it would require only routine skill in the art. Alternatively, or in conjunction with the design choices, these features of the character prove to be merely functional language, such that within an apparatus claim, the Examiner must show an equivalent structure to properly reject the claims and any functional language is not given the patentable weight that it would be given if written in a method claim. MPEP 2114 recites that “while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function”. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Federal Circuit, 1997). MPEP 2114 also recites “A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim”. *Ex parte Masbam*, 2 USPQ2d 1647 (Board of Patent Appeals & Interferences, 1987). Therefore, the Examiner submits that the limitations discussed above would have been obvious design choices as to the function of the disclosed visual character to those of ordinary skill in the art at the time of the invention. These obvious design elements for the character’s functionality would have produced predictable results in accordance with the specific design implemented. It appears that no unexpected results arise from the functionality of the character within the indicated claims. Therefore, for at least the reasons given, it would have been *prima facie* obvious to modify Ugawa to obtain the invention as specified in claims 80, 84, 87-95, & 97. One of ordinary skill in

the art would be motivated to produce new design and effects for the simple reason of providing new and exciting games for casino patrons in an industry where game machines are constantly being changed, upgraded, and re-designed to be appealing to the casino patrons, who are always looking for a new game to play. As such, new game designs appear to increase at least gaming revenue and casino appeal, which seems to be the underlying goal for gaming designers, thus, a skilled designer would be motivated to provide a plethora of special effects using the visual character.

**Claims 108-114:** Ugawa discloses the invention substantially as claimed except for explicitly disclosing that the character is arranged to appear on a bank of consoles in a coordinated manner, such as progressing/walking from one machine to another, where it may appear on one machine before it moves to the next or appear simultaneously on at least two machines such as when the character is in between two machines, or the like. Regardless of these deficiencies, it would have been notoriously well known in the art and would have required a mere design consideration. First, the Examiner submits that moving animations from one display to another is notoriously well known in the computer and gaming arts, such as a dual-monitor setup for a computer, where windows are transferable between two separate displays, or such as scrolling message displays in a bank of gaming machines, where a message essentially leaps from one machine's display to the next. These concepts are well known techniques in the art for moving animations between displays. Second, the Examiner submits that connecting multiple gaming machines to form a bank of gaming machines is also well known in the art. Accordingly, the Examiner submits that it would have required only routine skill in the art along with obvious design considerations to implement the visual character across a bank of gaming machines. The remaining functional language directed to what exactly the character will do, as discussed above, is a design consideration relating to ornamentation. The combination of known elements or techniques including multiple gaming



machines connectable into a bank of machines, an animated visual character, and moving graphics between multiple separate displays as taught by the art of record and known techniques to those skilled in the art, would have produced expected results for a skilled artisan, yielding an invention comprising an animated visual character inclusive in a bank of gaming machines in which the animated character is able to move across multiple displays for purposes of interactive gaming. Therefore, it would have been *prima facie* obvious to modify Ugawa with known elements and techniques to obtain the invention as specified in claims 108-114. As evidentiary references for those elements considered well known in the art, the Examiner submits, U.S. Patent No. 5,655,961 to Acres et al. disclosing networked gaming (i.e. banks of gaming machines). The concept behind dual-monitors or animation between separate displays has been well known in the computer arts for many years; thus, it appears unnecessary to provide a specific reference.

### ***Response to Arguments***

Applicant's arguments filed July 20, 2009 have been fully considered but they are not persuasive.

Applicant argues that Ugawa does not anticipate “said visual character being periodically displayed” and the “appearance of the character is triggered by a random event related to the amount of a bet placed” as recited in at least claim 72. Applicant supports this argument by indicating that since the read-for-winning state is a random event, the ready-for-winning state is not related to an amount of a bet placed. The Examiner respectfully disagrees and submits that the recited language is quite broad. In a broadest reasonable interpretation, the periodic determination of a ready-for-winning state is a random event and is based on an amount of bet placed, such as the amount of bet required to activate the machine. Clearly, the ready-for-win state nor any game play would commence unless a bet cross some minimum threshold is placed into the gaming machine, and thus, in a broadest reasonable interpretation, the periodic display of the character based on the ready-for-winning state is a random event based at least

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on the amount of bet placed, such as the wagering of at least some minimum bet amount. Consequently, Ugawa does appear to disclose "said visual character being periodically displayed" (such as based on the ready-for-winning state determination) and "the appearance of the character is triggered by a random event related to the amount of a bet placed" (i.e. a minimum bet amount into the gaming machine is required to proceed with game play that may randomly trigger the visual character).

As Applicant has not presented any specific arguments directed to the dependent claims, the Examiner has maintained the rejection set forth in the previous office action for at least claims 73, 74, 77-80, 84, 87-95, 97, 103, & 106-114, while updating such rejections to include any amended claim language.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MILAP SHAH whose telephone number is (571)272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Milap Shah/  
Examiner, Art Unit 3714